

REMARKS

In the Final Office Action¹ mailed November 23, 2010, the Examiner rejected claims 7-8 under 35 U.S.C. § 101 alleging that the claimed invention is directed to non-statutory subject matter; rejected claims 1 and 6-8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,751,399 to Okabayashi et al. ("*Okabayashi*") in view of U.S. Patent No. 7,352,955 to Kotani ("*Kotani*"); and objected to claims 2-5 and 9-12 as being dependent upon a rejected base claim, but allowable if rewritten in independent form.

By this response, Applicants have amended claims 1,3, 6-8, and 10. Claims 2 and 9 have been cancelled. No new matter has been added. Claims 1, 3-8, and 10-12 remain pending and under examination.

Rejection of Claims 7-8 Under 35 U.S.C. § 101

The Examiner rejected claims 7 and 8 under 35 U.S.C. § 101, alleging that the claims "direct to a program without specifying that the program is encoded or recorded on a non transitory computer readable medium" and "can be considered as a carrier wave signal that carries the program." *Office Action*, at p. 2. Applicants respectfully disagree with the Examiner's characterization of claims 7 and 8.

The Examiner alleges that "[t]he computer readable storage device in claim 8 can be considered as the recording medium of claim 7 since both of them having a program." *Office Action* at p. 2. Applicants respectfully submit this statement is

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

irrelevant to an analysis under § 101. The correct analysis is not whether a computer-readable storage device may encompass computer-readable media, such as the media described in paragraph [0181] of Applicants' specification, the analysis is whether a computer-readable storage device may encompass a transitory signal. A recording device is physical and cannot constitute a transitory signal under any interpretation of *signal*. Thus, the rejection of claim 8 is improper and should be withdrawn.

While Applicants disagree with the Examiner's characterization of claim 7, to advance prosecution, and without acquiescing to the propriety of the Examiner's rejection, Applicants have amended claim 7 to recite "[a] recording device storing a program." As discussed above, a device cannot cover a transitory propagating signal per se. Accordingly, Applicants submit claim 7 recites statutory subject matter.

For at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claims 7 and 8 under § 101.

Rejection of Claims 1 and 6-8 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1 and 6-8 under 35 U.S.C. § 103 as being obvious from *Okabayashi* in view of *Kotani*. However, to advance prosecution, and without acquiescing to the propriety of the Examiner's rejection, claim has been amended to incorporate the subject matter of claim 2, which the Examiner indicated would put the claim in condition for allowance. Similar amendments have been made to claims 6-8. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1 and 6-8 and timely allowance of the pending claims.

Objection to Claims 2-5 and 9-12

Applicants thank the Examiner for pointing out the allowability of the subject matter of claims 2-5 and 9-12. Applicants have incorporated the subject matter of claims 2 and 9 into independent claims 1 and 6 respectively, and cancelled claims 2 and 9. Therefore the objection to claims 2 and 9 is moot. Applicants also respectfully submit that, for the reasons cited above, amended claims 1 and 6 are allowable over the prior art. Because the independent claims are allowable, the objection to claims 3-5 and 10-12 as being dependent upon a rejected base claim should be rendered moot.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-8, and 10-12 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 3, 6-8, and 10 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 31, 2011

By: /Melanie Grover/
Melanie Grover
Reg. No. 63,599